

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

30566.17-US-C3

Application Number

10/642,857

Filed

August 18, 2003

First Named Inventor

Gregory A. Roy

Art Unit

2628

Examiner

Phu K. Nguyen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 39,187
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

/Jason S. Feldmar/

Signature

Jason S. Feldmar

Typed or printed name

310-641-8797

Telephone number

December 18, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Gregory A. Roy et al.	Examiner:	Phu K. Nguyen
Serial No.:	10/642,857	Group Art Unit:	2628
Filed:	August 18, 2003	Docket:	G&C 30566.17-US-C3
Title:	VECTOR-BASED GEOGRAPHIC DATA		

PRE-APPEAL BRIEF REQUEST FOR REVIEW ARGUMENTS

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the final Office Action dated July 14, 2006 and the mailing of the copy of the provisional application on October 17, 2006 (which restarted the mailing date of the final Office Action), Applicants hereby submit a Notice of Appeal accompanied by a Pre-Appeal Brief Request for Review. The claims have not been amended. Appellants submit that based on the claims and cited art, there are clear errors in the examiner's rejections and further, the rejections fail to establish essential elements needed for a prima facie rejection.

Failure to Establish Prima Facie Case under 35 U.S.C. §103(a)

Appellants directs the panel to pages 8-13 of the Request for Reconsideration filed by Appellant on April 24, 2006 for the substance of the arguments. Based on such arguments, Appellants submit that there is clear error in the examiner's rejection. Such failures are more clearly set forth below.

Map File that Provides a URL that Identifies a Storage Location of Vector Based Map Data

Appellant directs the Panel to pages 9-10 and 11-12 of the Request for Reconsideration filed by Appellant on April 24, 2006 for the substance of the arguments.

In response to the arguments, the final Office Action pages 17-19 respond to these prior arguments. Appellant respectfully traverses the assertions set forth therein. Firstly, in the Office Action, the Patent Office acknowledges the lack of teaching in Capps of the prioritized pool. However, now the Office Action is relying on Capps. Appellants note that nowhere in the cited text, the first Office Action, or the final Office Action, is there any description or mention of a prioritized pool of geometric entities. Similarly, neither the first Office Action nor the final Office Action mention or even remotely reference the prioritization of a particular geometric entity within such a pool. Instead, the Office Action merely disregards and ignores this explicit claim limitation. The disregard of a particular claim limitation establishes clear error in the rejection and omits an essential element needed to establish a prima facie rejection.

The Action further relies on Alexander to teach the claimed elements. Firstly, Appellants direct the attention of the panel to the argument below regarding the validity of Alexander as a reference. Secondly, Appellants note that while the Office Action states that Alexander asserts memory storage can be remotely accessed through Internet locations while citing col. 5, lines 57-65. Applicants note that col. 5, lines 57-65 does not mention or describe the Internet whatsoever. Accordingly, the Office Action is misinterpreting Alexander. Instead, in another portion of Alexander, Alexander merely states that a wireless packet radio link can use TCP/IP for compatibility with sending and receiving data over the Internet (see col. 12, lines 29-33). The claims do not recite the communication or sending/receiving data over the Internet. Instead, the claims explicitly provide that a map file has a URL that identifies a storage location of vector based map data. The present claims further recite that the vector based map data is obtained from such a storage location at the URL. To assert that the mere recitation of the Internet in extremely broad language (as in Anderson) teaches the specific use, implementation and invention recited in the present claims is wholly without merit. In this regard, the Examiner is omitting several essential elements needed to establish a prima facie rejection (i.e., the specific claim limitations described above).

Lastly, the Office Action equates a map database that is stored as a bitmap or vectors that point to a map character as equivalent to the claimed map file that contains URLs that identifies a storage location of vector based map data. Such an equivalency is meritless. In this regard,

Alexander's pointer to map characters are not remotely similar to (nor to they suggest or even hint at) a URL that identifies a storage location for vector based map data (as claimed).

Accordingly, Appellants submit the Office Action is clearly in error and has various omissions that fail to establish a prima facie case of obviousness.

Ability to Determine Storage Location of Vector Map Data that Defines a Map Object for a Requested Map Picture

Appellants direct the attention of the panel to pages 9-10 of the Request for Reconsideration filed by Appellant on April 24, 2006 for the substance of the arguments.

In response to earlier arguments, the final Office Action responds on page 19. Appellants again traverse the assertions set forth therein and note that instead of specifying where the references teach a storage location or a URL that identifies such a storage location, the Office Action state that the references teach a map picture having vector based data and then concludes that the references must have ability to determine where information is located and therefore it is clear that the ability to determine the storage location is within the cited reference teachings. Such a conclusory based rejection without any support in the references is clearly in error. Under MPEP §2142 and 2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." In this regard, to summarily conclude that a claim element is obvious without any support for such a conclusion is wholly without merit. In view of the above, Appellants submit that the rejection is clearly in error and contains various omissions of essential elements that are needed for a prima facie rejection.

Lack of Motivation to Combine the References

Appellants direct the attention of the panel to page 13 of the Request for Reconsideration filed by Appellant on April 24, 2006 for the substance of the arguments. In response, the final Office Action asserts:

(5) There is no motivation to combine the cited references.

The modification of the Goodenough's teach to configure the claimed invention is implemented by storing the map representing the area's features in a vector format (Drutman, page 111-528, column 2, lines 28-30) in a location in memory identifiable by its URLs for communicating in World Wide Web (Alexander, connection of the system to Internet, column 12, lines 29-33). The motivation for storing the map representing the objects in a vector format in a location in memory identifiable by its URLs is the simplicity of map file with its vector-based objects communicated through their URLs and the richness of resource provided in the Internet (Alexander, column 5, lines 57-65).

Appellants again direct the attention of the panel to the arguments below regarding the validity of Alexander as a reference. Further, Appellants submit that there is no motivation within the references that does not rely on impermissible hindsight provided by the teaching of the present invention.

Alexander is Not a Valid Reference

Appellants direct the attention of the panel to pages 11-12 of the Request for Reconsideration filed by Appellant on April 24, 2006 for the substance of the arguments. In response, the Office Action asserts:

(6) Alexander is not a valid reference with respect to the present invention.

Alexander claims benefit of its filing date through its provisional application 601025,528 which has its filing date September 6, 1996 predated the present application effective filing date (October 30, 1996). In its provisional application, Alexander teaches the vector map data (page 1, line 17-18), access data through Internet (page 6, lines 19-20; page 7, lines 5-7). Examiner attaches a copy of the US provisional application serial number 601025,528.

The response asserts that Alexander, page 6, lines 19-20 and page 7, lines 5-7 teaches the access of data through the Internet. Appellant respectfully disagrees. The only text in the provisional that refers to the Internet is on page 9, lines 14-17 which refers to a wireless packet radio link that can use TCP/IP for compatibility with sending and receiving data over the Internet. As described above, such text does not teach the specifically claimed limitations of the present invention.

Regardless of whether the Examiner agrees with the above assertion regarding the lack of teaching, Alexander still cannot be used to reject the present invention because it is an invalid reference for the purpose on which it is relied. For example, Appellants note that the Office Action relies on Alexander col. 5, lines 57-65 in numerous parts of the rejection. This portion of text refers to Alexander Fig. 17. Appellants note that neither Figure 17, nor the text of col. 5, lines 57-65 appear anywhere in Alexander's provisional application. Again, to rely on a provisional filing date to

beat the date of the present invention, two conditions must be satisfied: (1) the subject matter of the claim in the issued patent must be supported in accordance with 35 U.S.C 112, first paragraph, in the earlier filed application, and (2) the subject matter used in the rejection must be disclosed in the earlier-filed application in compliance with 35 U.S.C. 112, first paragraph, in order for that subject matter to be entitled to the earlier filing date under 35 U.S.C. 102(e). (See MPEP 201.11 and MPEP 706.02(f)(1); *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 47 USPQ2d 1829 (Fed. Cir. 1998); *In re Scheiber*, 587 F.2d 59, 199 USPQ 782 (CCPA 1978); *Studiengesellschaft Kohle m.b.H. v. Shell Oil Co.*, 112 F.3d 1561, 1564, 42 USPQ2d 1674, 1677 (Fed. Cir. 1997); and *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294, 63 USPQ2d 1843, 1846 (Fed. Cir. 2002)). These elements have not been established in the Office Action at all. Further, the lack of existence of relied upon portions in the provisional application is clearly an error in the rejection. In view of the above, the reliance on Alexander's provisional application filing date is improper and meritless.

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicant's undersigned attorney.

Respectfully submitted,

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Date: December 18, 2006

By: /Jason S. Feldmar/
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